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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,267	02/24/2004	Thomas M. Sladek	2727	3856

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EXAMINER

VU, MICHAEL T

ART UNIT PAPER NUMBER

2683

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/785,267	Applicant(s) SLADEK ET AL.	
	Examiner Michael Vu	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-13 is/are rejected.
- 7) ☒ Claim(s) 6 and 14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 February 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/19/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 - 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3, 6-20 of U.S. Patent No. 6,718,178. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the continuation are broader than the ones in the patent and encompasses a similar invention as recited in the copending claims, i.e., receiving a single mode wireless card is obvious modification of a dual mode.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3-5, 7-8, 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushiyama (US 6,349,140) in view of Diachina (5,768,276).

Regarding **claim 1**, Ushiyama teaches a method comprising: when a person tunes a television to a given station, indicating what station is being watched (Abstract, Fig. 4-6, Fig. 13, C4, L60-67 to C4, L1-22, C6, L51-67 to C7, L1-32). **But is silent on a** video server responsively sending a Short Message Service (SMS) message to a designated destination. However, Diachina teaches the digital control channels having logical channels supporting broadcast Short Message Service (SMS) (Title, Abstract, C23, L9-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ushiyama, such that a video server responsively sending a Short Message Service (SMS) message to a designated destination, to provide the use of digital control channels in a multiple access such as cellular phone, to increase the capacity/quality of supporting the different of message services.

Regarding **claims 3 and 11**, Ushiyama teaches a method of claim 2, further teaches wherein the host device comprises a cable TV-receiver (C1, L13-19, and claim #5).

Regarding **claims 4 and 12**, Ushiyama teaches a method of claim 2, further teaches wherein the host device comprises a satellite TV-receiver (C1, L13-19).

Regarding **claims 5 and 13**, Ushiyama teaches a method of claim 2, further teaches wherein the person tunes the television by tuning the host (C1, L13-19).

Regarding **claim 7**, Ushiyama teaches a method comprising: detecting that a person has tuned a television to a given station; responsively sending an informational message that indicates what station is being watched (Abstract, Fig. 4-6, Fig. 13, C4, L60-67 to C4, L1-22, C6, L51-67 to C7, L1-32).

Regarding **claim 8**, Ushiyama teaches a method of claim 7. **But is silent on** wherein the informational message comprises a Short Messaging Service (SMS) message. However, Diachina teaches the digital control channels having logical channels supporting broadcast Short Message Service (SMS) (Title, Abstract, C23, L9-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ushiyama, such that wherein the informational message comprises a Short Messaging Service (SMS) message, to provide the use of digital control channels in a multiple access such as cellular phone, to increase the capacity/quality of supporting the different of message services.

5. Claims 2, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ushiyama (US 6,349,140) in view of Ellis (2004/0117831).

Regarding **claims 2 and 10**, Ushiyama teaches a method of claim 1, **But is silent on** wherein the video server comprises a host device serving the television. However, Ellis teaches a system for providing interactive television programming features, which provide by user television equipment that relate to a specific interest or programming category (Abstract, Fig. 1A to Fig. 1D, [0092-0096, 0211]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ushiyama, such that wherein the video server comprises a host device serving the television, to provide many program guides allow the users to view television programs/control/monitor in a specific category.

Regarding **claim 9**, Ushiyama teaches a method of claim 7. **But is silent on** wherein sending the informational message comprises a video server sending the informational message. However, Ellis teaches a system for providing interactive television programming features, which provide by user television equipment that relate

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to a specific interest or programming category (Abstract, Fig. 1A to Fig. 1D, [0092-0096, 0211]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ushiyama, such that wherein sending the informational message comprises a video server sending the informational message, to provide many program guides allow the users to view television programs/control/monitor in a specific category.

Allowable Subject Matter

6. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

For **claims 6 and 14**, the prior art of this record does not disclose or teach wherein sending an SMS message to a designated destination comprises sending the SMS message to a parent of the person.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Ushiyama US 6,349,140
2. Ellis 2004/0117831
3. Ellis 2005/0204382
4. Diachina 5,768,276

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5. Svennesson 6,005,845

6. Shimomura 2005/0169255

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Vu whose telephone number is (571)272-8131. The examiner can normally be reached on 8:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael T. Vu



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